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IN THE

Supreme Court of the United States

MURRAY HILL PUBLICATIONS, INCORPORATED,

Petitioner,

v.

TWENTIETH CENTURY FOX FILM CORPORATION,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED FOR REVIEW

I. WHETHER THIS COURT SHOULD GRANT THE INSTANT PETITION FOR WRIT OF CERTIORARI IN ORDER TO REVIEW THE ERRONEOUS DECISION OF A PANEL OF THE SIXTH CIRCUIT WHEREIN THE PANEL PURPORTED TO CREATE A NEW RULE OF LAW, UNPRECEDENTED IN THE HISTORY OF COPYRIGHT JURISPRUDENCE AND NEVER BEFORE RECOGNIZED BY THIS COURT OR ANY CIRCUIT COURT OF APPEALS, WHICH:

   A. AFFORDS COPYRIGHT PROTECTION TO NON-PROTECTIBLE IDEAS IN CONTRADICTION OF FUNDAMENTAL COPYRIGHT LAW;

   B. CONFLATES THE AFFIRMATIVE DEFENSE OF INDEPENDENT CREATION WITH THE SUBSTANTIAL SIMILARITY ANALYSIS THEREBY ENTIRELY GUTTING AND ELIMINATING THE NECESSITY OF PROVING SUCH AFFIRMATIVE DEFENSE BY THE DEFENDANT IN A COPYRIGHT INFRINGEMENT ACTION; AND

   C. REMOVES THE FACTUAL DETERMINATION OF SUBSTANTIAL SIMILARITY AND THE AFFIRMATIVE DEFENSE OF INDEPENDENT CREATION FROM THE EXCLUSIVE PROVINCE OF THE FINDER OF FACT.

II. WHETHER THIS COURT SHOULD GRANT THE INSTANT PETITION FOR WRIT OF CERTIORARI IN ORDER TO RESOLVE A SPLIT AMONG THE CIRCUIT COURTS OF APPEALS WITH RESPECT TO THE TEST TO BE APPLIED WHEN ANALYZING SUBSTANTIAL SIMILARITY BETWEEN A COPYRIGHTED WORK AND AN ALLEGEDLY INFRINGING WORK.

STATEMENT PURSUANT TO RULE 29.6

Petitioner, Murray Hill Publications, Incorporated, has no parent corporation and no publicly held company owns 10% or more of its stock.

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OPINIONS BELOW

The published opinion of the Sixth Circuit Court of Appeals from which Petitioner, Murray Hill Publications, Inc. ("Murray Hill"), seeks review was issued on March 19, 2004 (attached hereto as Addendum, Exh. 1). On November 9, 2001, the District Court entered two nonpublished Opinions, one denying Defendant's Motion for New Trial and the other Denying in Part and Granting in Part Fox's Renewed Motion for Judgment as a Matter of Law (attached hereto respectfully as Addendum, Exh. 2 and 3). Murray Hill's timely Petition for Rehearing and/or Rehearing *En Banc* was denied by the Sixth Circuit on June 18, 2004 (attached hereto as Addendum, Exh. 4).

STATEMENT OF JURISDICTION

The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

CONSTITUTIONAL PROVISION INVOLVED

Article I, Section 8 of the United States Constitution. The pertinent portions of this Constitutional provision are attached hereto as Addendum, Exhibit 5.

STATEMENT OF THE CASE

Murray Hill alleged that Respondent, Twentieth Century Fox Film Corporation ("Fox"), intentionally and willfully infringed upon Murray Hill's exclusive rights in its original screenplay (the "Screenplay") when Fox put into production a motion picture under the name "Jingle All the Way" ("JATW"), which included original copyrighted material from Murray Hill's Screenplay, without authorization or permission. R. 109 Am. Compl.[1]

The Screenplay was written by Brian Webster ("Webster") in 1989, and first registered with the United States Copyright Office on October 16, 1989. R. 339 Tr. Exh. Z7. Although the 1989 Registration was canceled for an administrative reason, Webster re-registered the Screenplay on

1. "R. __" refers to the docket number in the United States District Court for the Eastern District of Michigan.

January 8, 1991. *Id.*, Tr. Exh. A8; Webster at TR Vol. II 99-100[2]. Changes and revisions to the Screenplay through 1993 were registered pursuant to a 1996 Copyright Registration. R. 339 Tr. Exh. C8.

The Screenplay chronicles the quest of a Caucasian mother, Clare, attempting to obtain a hard-to-get science fiction action figure toy as a Christmas gift for her son. R. 75 Murray Hill's Brief in Opposition to Fox's Motion for Summary Judgment, Exh. 13 ("Exh. 13"). In the course of this pursuit, Clare competes with an African-American woman, similarly seeking to give the action figure doll as a Christmas gift. *Id.* Clare feels it is particularly important to obtain this gift for her son because the child lacks a male role model as a result of Clare's divorce. *Id.* Clare is in part spurred to obtain the toy by viewing drawings made by her son of the action figure. *Id.* Clare goes to great lengths to acquire the toy for her son, including breaking into a building and stealing the toy. *Id.* However, Clare has a change of heart due to the immorality of the theft. *Id.* The work culminates with a greater bond being formed between Clare and her son. *Id.*

From 1989 forward, Webster and his agent, Carolyn Hodges ("Hodges"), sent the Screenplay to numerous people in the motion picture industry in an effort to sell the rights to the Screenplay. R. 158 Murray Hill's Brief in Opposition to Fox's Motion in Limine to Preclude Murray Hill's Access Theories, Exh. 4 at 4-6. Specifically, Webster gave the Screenplay to his neighbor, Lori Dewey ("Dewey"), in 1991. Webster at TR Vol. II 110-111. Dewey subsequently sent the script to her brother-in-law, Alex Gartner ("Gartner"). *Id.* Gartner does not deny receiving a copy of the Screenplay. Gartner at TR 16-18. In fact, Gartner recalls Webster calling, using Dewey's name and asking if he could send material to Gartner. *Id.* at 17. Gartner worked for City Light Films at the time, but moved to Fox 2000,

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2. "[Name] at TR Vol. __" refers to testimony given by the witness at trial.

a division of Fox, in October 1994 as a senior vice president of production. *Id.* at 9.

In October 1993, Murray Hill, by and through its president, Robert Laurel ("Laurel")[3], entered into an option agreement, which was subsequently renewed, with Webster in connection with the Screenplay in order to pursue a co-production arrangement with a major film studio such as Fox. Laurel at TR Vol. V at 10-11. Webster ultimately transferred all rights and interest in the Screenplay in perpetuity to Murray Hill. R. 339 Tr. Exh. I8.

On November 16, 1993, just after Murray Hill agreed to acquire rights in the Screenplay, Laurel met with Thomas Rothman ("Rothman"), a senior executive at Samuel Goldwyn ("Goldwyn"), and Julie Glucksman, a story editor at Goldwyn, regarding the Screenplay, and the associated marketing and toy tie-ins. Laurel at TR Vol. V 19-32. Rothman expressed great enthusiasm and interest in the Screenplay. *Id.* at 27. Laurel sent Rothman the Screenplay via Federal Express on November 22, 1993. R. 339 Tr. Exh. O8. Rothman joined Fox as president of Searchlight, a Fox division, in June or July of 1994, although he held discussions with Fox much earlier. Rothman at TR 8-9, 25. Ultimately Rothman became the senior executive in charge of the production of JATW for Fox[4]. *Id.* at 32-35.

In June 1994, Laurel sent the Screenplay to John Matoian ("Matoian), president of Fox Family Films, a division of Fox. R. 339 Tr. Exhs. F6, Q8. Fox passed on co-producing the Screenplay. *Id.*, Tr. Exh. Z5.

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3. Laurel was a musician, composer, writer and producer. Laurel at TR Vol. IV at 76-79. Among other things, Laurel, through his production company, produced the motion picture "The Rosary Murders," based upon the best-selling novel by William X. Kienzle. *Id.* at 80-82. Laurel passed away on September 4, 2001.

4. Rothman's phone logs and business records confirm meetings with the writers and producers of the film during the creative process of revision and production of JATW. R. 339 Tr. Exh. T17.

Fox's infringing work, JATW, was purportedly written by an in-house script reader at Fox named Randy Kornfield a/k/a Ed McQueen ("Kornfield") in July 1994 (approximately *six years after* Webster's script was written). *Id.*, Exh. 10.

JATW chronicles the quest of a Caucasian workaholic father, Howard, to obtain a hard-to-get science fiction action figure toy as a Christmas gift for his son. R. 75 Exh. 13. In the course of this pursuit, Howard competes with an African-American man similarly seeking to give the action figure toy as a Christmas gift. *Id.* Howard feels it is particularly important to obtain this gift for his son because he has been an absentee father due to his work, and thus the child has lacked a male role model. *Id.* Howard is in part spurred to obtain the toy by viewing drawings made by his son, including one of the action figure. *Id.* Howard goes to great lengths to acquire the toy for his son, including breaking into a building and stealing the toy. *Id.* However, Howard quickly has a change of heart due to the immorality of the theft. *Id.* The work culminates with a greater bond being formed between Howard and his son. *Id.*

Kornfield registered a 5½ page treatment (the "Treatment") called "A Christmas Hunt" with the Writer's Guild of America (the "WGA") in January 1994. *Id.*, Tr. Exh. 49. The first actual script of JATW credited to Kornfield is dated November 29, 1994, well after Gartner and Rothman took positions at Fox, and after Matoian had received a copy of the Screenplay at Fox in June 1994. *Id.*, Tr. Exhs. N4, F6.

The very same script reader at Fox covered[5] both the Screenplay and Kornfield's JATW script. Rudy Romero ("Romero") covered the Screenplay on July 9, 1994. *Id.*, Tr. Exhs. V5A, A6. Romero then read and covered JATW

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5. In film studio parlance, "covered" means that a script reader provides a short summary and analysis of submitted scripts in order to provide studio executives with a brief preliminary overview of the material.

authored by Kornfield[6], for the first time on October 25, 1994[7], just over three months later[8]. *Id.*, Tr. Exh. V5A. Romero described the two screenplays in similar manners in his coverages, yet testified that he could not recall the Screenplay. Romero at Dep. Tr. 20-24[9]. In his coverage, Romero described Murray Hill's script as "a mother's frantic but ultimately failed effort to secure a scarce toy that her son covets ironically teaches her the true meaning of Christmas." R. 339 Tr. Exh. A6. Romero described JATW as "a neglectful but well-meaning father's . . . scramble across the city to find the much sought after and therefore virtually impossible to find toy." *Id.*, Tr. Exh. V5A. Romero comments on both scripts by making reference to the Cabbage Patch Doll and Power Rangers Christmas toy crazes. *Id.*, Tr. Exhs. V5A, A6. Romero also similarly described the tone of the two works. Specifically, Romero characterized Bess' actions in the Screenplay as "misadventures" which he considered "ripe with farcical potential." *Id.*, Tr. Exh. A6.

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6. During the proceedings in the District Court, Fox suggested that Kornfield used an alias on the first draft of JATW because he was a script reader at Fox and did not want his identity disclosed to Fox; however, it is clear from the notation on Romero's coverage that it was common knowledge at Fox that the script was purportedly written by Kornfield. R. 339 Tr. Exh. V5A.

7. Despite the existence of Romero's October 25, 1994 coverage of Kornfield's purported first draft, the earliest script by Kornfield produced by Fox and/or the production company, 1492 Pictures, is actually dated November 29, 1994, over one month *after* Romero purportedly prepared his coverage of JATW. R. 339 Tr. Exh. N4.

8. Romero's October 25, 1994 coverage of JATW indicates that the length of the script he reviewed was 112 pages. R. 339 Tr. Exh. V5A. The November 29, 1994 script is 112 pages, which matches the number of pages indicated on the October 25, 1994 coverage. *Id.*, Tr. Exh. N4. The only logical conclusion from this evidence is that Fox backdated Romero's October 25, 1994 coverage in order to baldly assert that there was a script that predated the November 29, 1994 script. *Id.*

9. "[Name] at Dep. Tr. __" refers to the witness' deposition testimony, which was read into the record at Trial.

At the very same time Kornfield was purportedly writing JATW, he was also admittedly working alongside Romero as a story analyst at Fox. Kornfield at TR Vol. XIV 26. In addition, Kornfield was close friends with Stephen Bulka ("Bulka"), a former Fox story editor who became vice president of development for Nickelodeon Pictures ("Nickelodeon")[10]. Bulka had an office on the Fox lot inasmuch as Nickelodeon had a deal to develop films which would be distributed by Fox. Bulka at Dep. Tr. 8-9.

Bulka and Kornfield personally pitched the JATW script to at least two Fox executives. Kornfield at TR. Vol. XI at 53, 73; Bulka at Dep. Tr. 17-18. Kornfield was personally present at one of the "pitches," and he is referenced as the purported author of the script on all scripts in the Fox file. R. 339 Tr. Exhs. A17, C6.

Kornfield ultimately sold his November 29, 1994 JATW script to his employer, Fox. R. 339 Tr. Exh. 133. Kornfield testified that he did not reveal his true identity as the author of JATW to Fox until after Fox had purchased the script. Kornfield at TR Vol. XIV 39-40. Michael Barnathan ("Barnathan"), an executive at 1492 Pictures ("1492"), the production company for whom Fox purchased the JATW script, however, testified that Fox purchased the November 29, 1994 script for 1492, which script clearly lists *Kornfield* as the author. R. 339 Tr. Exh. N4; Barnathan at Dep. Tr. 59-61. In fact, all of the scripts produced by Fox and 1492 in this action list Kornfield as the author. R. 339 Tr. Exhs. N4, P4-T4.

In or around February 1996, Laurel learned that Fox intended to put into production JATW when he received a

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10. Kornfield reluctantly admitted at trial that he, Romero and Bulka, another former Fox script reader, are friends and co-workers, who continue to have a social relationship to this day. Kornfield at TR Vol. XI 39. Kornfield had previously denied this friendship in his deposition testimony. September 18, 1999 Deposition of Kornfield at 66.

package containing a draft of the JATW script and an article from Daily Variety. Laurel Vol. V at TR 48-49; R. 339 Tr. Exh. X9. As soon as Laurel reviewed this material, he realized that Fox had stolen the Screenplay, and further realized that any future potential market for the Screenplay was destroyed by Fox's infringing project. Laurel at TR Vol. V 49-50, 53-54.

Laurel forwarded such materials to Murray Hill's copyright attorneys in order to obtain an objective opinion[11]. *Id.* at 55-56. After reviewing such materials, Murray Hill's copyright attorneys sent a cease and desist letter to Fox, warning Fox that its continued production of JATW represented an infringement of Murray Hill's exclusive rights to the Screenplay. *Id.* at 56; R. 339 Tr. Exh. C7. In total, Murray Hill's counsel sent eight cease and desist letters demanding that Fox cease production of its infringing work, and expressly notifying Fox of Murray Hill's exclusive copyright in the Screenplay. R. 339 Tr. Exhs. C7-H7, L7.

Despite the repeated notices to cease and desist, Fox produced and released a theatrical film, home video and DVD of JATW which infringed upon Murray Hill's copyrighted Screenplay. *Id.*, Tr. Exh. 1. Fox additionally produced a motion picture soundtrack, and licensed various toys and other merchandise related to the film. *See, e.g., Id.*, Tr. Exhs. Q3, 166.

On March 6, 2001, following a full trial on the merits, the jury found Fox liable to Murray Hill for copyright infringement. R. 247 Verdict. The jury awarded damages in the amount of $19,000,000 as follows: (1) $1,000,000 for lost producer's fees; (2) $500,000 for lost writer's fees; (3) $2,000,000 for lost goodwill; (4) $500,000 for lost merchandising royalties; and (5) $15,000,000 for future profits. *Id.*

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11. Likewise, the author of the Screenplay, Webster, testified that, after reviewing such materials, he definitively felt his work had been stolen. Webster at TR vol. III at 24.

On March 14, 2001, the District Court entered a Judgment in accord with the jury's verdict. R. 255 Judgment.

On March 28, 2001, Fox filed its Renewed Motion for Judgment as a Matter of Law (the "Renewed Motion for JML") and Motion for New Trial (jointly, the "Post-Trial Motions"). R. 259 Fox's Renewed Motion for JML; R. 258 Fox's Motion for New Trial.

Murray Hill filed Briefs in Opposition to Fox's Post-Trial Motions. R. 286 Murray Hill's Brief in Opposition to Fox's Motion for New Trial; R. 285 Murray Hill's Brief in Opposition to Fox's Renewed Motion for JML.

On November 9, 2001, the District Court entered its Opinion Denying in Part and Granting in Part Fox's Renewed Motion for JML. Addendum, Exh. 3. Therein, the District Court denied Fox's Renewed Motion for JML with respect to the liability of Fox and with respect to damages awarded by the jury for lost writer's and producer's fees. *Id.* The District Court granted Fox's Renewed Motion for JML with respect to the jury's award of future profits, lost merchandising royalties and lost goodwill. *Id.* Also on November 9, 2001, the District Court entered its opinion denying Fox's Motion for New Trial. R. 317 New Trial Op.

On November 19, 2001, the District Court entered its Amended Judgment in accord with its November 9, 2001 Orders. R. 320 Am. Judgment.

On December 3, 2001, Fox filed its Notice of Appeal with respect to the District Court's Orders denying its motion for new trial and denying in part its Renewed Motion for JML. R. 324 Notice of Appeal.

On December 4, 2001, Murray Hill filed its Notice of Cross Appeal with respect to the District Court's Orders granting in part Fox's Motion for JML by striking portions of the jury's damage award and denying Murray Hill's request for attorney fees. R. 328 Notice of Cross Appeal.

On March 19, 2004, a panel (the "Panel") of the Sixth Circuit reversed the jury verdict rendered in favor of Murray Hill, wherein the jury, after fully reviewing the works at issue, determined that JATW did in fact infringe upon the Screenplay[12]. *Murray Hill Pubs., Inc.* v. *Twentieth Century Fox Film Corp.*, 361 F.3d 312 (6th Cir. 2004) (attached hereto as Addendum, Exh. 1). The Panel erroneously determined that elements which Fox asserted were derived from the mere ideas in the Treatment should be filtered out of JATW prior to performing the substantial similarity analysis between JATW and the Screenplay. *Id.* The Panel's reasoning was utterly flawed inasmuch as Murray Hill presented substantial evidence at trial that Fox used the Screenplay as a blueprint during the process of adding and dropping elements from various iterations of its scripts which ultimately resulted in JATW. The jury determined, as a matter of fact, that Fox had indeed used the Screenplay as the basis for JATW and *rejected* Fox's assertion that it derived JATW solely from the Treatment (*i.e.*, that Fox independently created JATW). R. 247 Verdict. The Panel nonetheless *usurped the jury's exclusive role as finder of fact* and summarily determined that Fox was immune from a claim of copyright infringement because its 5½ page Treatment containing *bare ideas* pre-dated Fox's admitted access to the Screenplay, which contained the *specific expression* appropriated by Fox for use in JATW.

Furthermore, the Panel erroneously held that an alleged infringer can avoid liability merely by demonstrating the prior

12. Tellingly, two separate District Court judges thoroughly reviewed the evidence in this case before it went to the jury, and both determined that there were genuine issues of material fact which could only be resolved by a jury. R. 80 Order Denying Motion for Summary Judgment; R. 246 Order Denying Motion for Judgment as a Matter of Law. In addition, Judge Battani again reviewed the evidence following the jury's verdict in connection with Fox's Renewed Motion for JML, and once again determined that more than sufficient evidence had been presented at trial by Murray Hill to sustain the jury's verdict of copyright infringement by Fox. Addendum, Exh. 3.

existence of elements, including mere non-protectible ideas as in the instant case, in its work pre-dating its access to the copyrighted work. *Murray Hill Pubs., supra.* The Panel determined that, even where the jury *rejects* the defendant's assertion that it based its allegedly infringing work upon such elements and not upon any protectible elements of the copyrighted work, summary judgment is appropriate because such elements must be excluded from the substantial similarity analysis and therefore removed from a determination by the finder of fact[13].

On April 2, 2004, Murray Hill timely filed its Petition for Rehearing and/or Rehearing *En Banc* (the "Petition for Rehearing") pointing out the critical flaws in the Panel's opinion. The Petition for Rehearing was denied on June 18, 2004 pursuant to an unsigned Order issued by the Sixth Circuit. Addendum, Exh. 4.

As a result of the Panel's fatally flawed ruling, the Panel clearly erred on issues of exceptional importance inasmuch as its opinion: (1) afforded copyright protection to a non-copyrightable Treatment consisting of mere ideas in contradiction of fundamental copyright law recognized by every Circuit Court of Appeals; (2) conflated the affirmative defense of independent creation with the substantial similarity analysis thereby entirely gutting and eliminating the necessity of satisfying such affirmative defense by the defendant in a copyright action in contradiction of Sixth Circuit precedent; and (3) removed the factual determination of substantial similarity and the affirmative defense of independent creation from the exclusive province of the finder of fact in contradiction of the clear precedent of this Court, the Sixth Circuit itself and every other Circuit Court of Appeals.

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13. The substantial similarity analysis is recognized in every Circuit and has, until the Panel's Opinion in this case, always required that a comparison be made between the protectible elements in the copyrighted work and the allegedly infringing work *as a whole.*

REASONS FOR GRANTING THE PETITION

I. The Instant Petition Should Be Granted Because The Panel's Ruling Conflicts With Prior Opinions Of This Court And The Opinions Of The Circuit Courts Of Appeals, Adopts A Rule That Is Not Recognized In Any Circuit Court Of Appeals And Will Destroy Well-Settled Copyright Principles.

Because this case involves extremely important questions of copyright law which go to the very nature and extent of copyright protection afforded to authors under the Constitution and the laws of the United States[14], and the Panel's decision utterly altered the law of copyright in the Sixth Circuit such that it no longer comports with the fundamental tenets of copyright law nor the well-settled law of any other Circuit or the precedent of this Court, this Court should grant the instant Petition in order to fully review the opinion of the Panel.

A. The Panel's Opinion Conflicts with the Sixth Circuit's own Decision in *Kohus* and the Test for Substantial Similarity Set Forth Therein.

Because the courts have recognized that, as a practical matter, there rarely will be direct evidence of copying, the method by which an aggrieved plaintiff must establish copyright infringement is by proving access to the copyrighted work by the alleged infringer, and substantial similarity between the copyrighted work and the allegedly infringing work. *Wickham* v. *Knoxville Int'l Exposition, Inc.*, 739 F.2d 1094, 1097 (6th Cir. 1984). It is undisputed that every Circuit Court of Appeals, including the Sixth Circuit, has expressly accepted this inferential method for establishing a *prima facie* case of copyright infringement.

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14. Copyright protection is authorized by the Constitution pursuant to U.S. Const. Art. I, § 8 (attached hereto as Addendum, Exh. 5). This Constitutional mandate is implemented by statute through 17 U.S.C. § 101 *et seq.* (the "Copyright Act").

As the Panel recognized, the issue of access is usually the less problematic of the two prongs, and indeed access to the Screenplay by Fox was *not* at issue in the appeal[15].

Federal Courts have developed a number of tests with respect to the substantial similarity analysis. For instance, the Ninth Circuit implements a two part extrinsic/intrinsic test[16]. The Ninth Circuit describes its test as follows:

> We employ a two-part analysis in this circuit — an extrinsic test and an intrinsic test — to determine whether two works are substantially similar. The "extrinsic test" is an objective comparison of specific expressive elements. "The test focuses on articulable similarities between the plot, themes, dialogue, mood, setting, pace, characters, and sequence of events in two works." Although originally cast as a "test for similarity of ideas," the extrinsic test, now encompassing all objective manifestations of expression, no longer fits that description. The "intrinsic test" is a subjective comparison that focuses on "whether the ordinary, reasonable audience" would find the works substantially similar in the "total concept and feel of the works." *Cavalier* v *Random House, Inc.*, 297 F.3d 815, 822 (9th Cir. 2002) (citations omitted).

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15. In this case, the Panel correctly recognized that "Fox did have access to the [Screenplay] before it registered the JATW screenplay and before production of the JATW movie." *Murray Hill Pubs.*, 361 F.3d at 324.

16. However, for the purposes of summary judgment, the Ninth Circuit applies only the extrinsic portion of the test. *Rice* v. *Fox Broad. Co.*, 330 F.3d 1170, 1174 (9th Cir. 2003).

The Second Circuit implements the "ordinary observer" test for substantial similarity. The Second Circuit describes its "ordinary observer" test as follows:

> The standard test for substantial similarity between two items is whether an "*ordinary observer*, unless he set out to detect the disparities, would be disposed to overlook them, and regard [the] aesthetic appeal as the same." If "an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work," then the two products are substantially similar. *The fact-finder must examine the works for their "total concept and feel."* *Yurman Design, Inc.* v. *PAJ, Inc.*, 262 F.3d 101, 111 (2d Cir. 2001) (citations omitted, emphasis added)[17].

Until recently, the Sixth Circuit had not adopted "any of the refined versions of the substantial similarity test[18]." 361 F.3d at 318 (footnote added). In *Kohus* v *Mariol*, 328 F.3d 848 (6th Cir. 2003), *reh'g and reh'g en banc den.*, 2003 U.S. App. LEXIS 15531 (6th Cir. 2003), which was decided by the Sixth Court during the pendency of the appeal at bar, the Sixth Circuit purported to adopt the test used by the United States Court of Appeals for the District of Columbia Circuit as set forth in *Sturdza* v. *United Arab Emirates*, 281 F.3d 1287 (D.C. Cir. 2002).

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17. The different tests applied by the different Federal Courts of Appeals can lead to disparate results. Thus, this reason alone warrants acceptance of the instant Petition so that this Court may declare a uniform test for substantial similarity to be applied among all the lower Federal Courts.

18. This Court has not set forth a uniform test for substantial similarity to be applied by the lower Federal Courts.

In *Kohus*, the Sixth Circuit described the *Sturdza* test as follows:

> [T]he first step "requires identifying which aspects of the artist's work, if any, are protectible by copyright,"; the second "involves determining whether the allegedly infringing work is 'substantially similar' to protectible elements of the artist's work[.]" We approve this method, and adopt it. *Kohus*, 328 F.3d at 855.

The *Kohus* Court held that "[t]he essence of the first step is to filter out the unoriginal, unprotectible elements that were not independently created by the inventor [of the copyrighted work]." *Id.* The *Kohus* Court further held that "the second step is to determine whether the allegedly infringing *work* is substantially similar to the *protectible elements* of the original." *Id.* (emphasis added)[19]. Thus, the Panel's decision in this appeal was bound by *Kohus* under the rules of *stare decisis*. *United States* v. *Roper*, 266 F.3d 526, 530 (6th Cir. 2001) ("[A] prior published opinion of this court is binding unless either an intervening decision of the United States Supreme Court requires modification of the prior opinion or it is overruled by this court sitting *en banc*.").

The Panel reached its unprecedented decision, which directly contradicts *Kohus*, by concluding that purportedly independently created elements are to be "filtered out" of the allegedly infringing work prior to performing the substantial similarity analysis. Thus, before performing this flawed version of the substantial similarity analysis, the Panel "filtered out" of JATW all elements which, according to Fox, also appeared in the Treatment that predated Fox's access to the Screenplay even if the Treatment consisted of ideas as opposed to expression.

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19. Tellingly, the *Kohus* Court made no suggestion that any matter should be filtered out of the allegedly infringing work, and in fact held that the protectible elements of the copyrighted work should be compared to the allegedly infringing work as a whole. *Id.*

The Panel then concluded that the remaining similarities between *JATW and the Screenplay were too insubstantial for any* reasonable jury to find infringement.

Although the Panel purported to adopt the test used by the District of Columbia Circuit, as set forth in *Sturdza, supra*, in fact the Panel has created out of whole cloth a test that is directly contrary to the logic, reasoning, the express holding of *Sturdza* and the Sixth Circuit's own decision in *Kohus*, and is unprecedented in the history of copyright jurisprudence. Specifically, it is crystal clear in the D.C. Circuit, and in every other Circuit, that a comparison must be made between the protectible elements of the copyrighted work and the *entire allegedly infringing work*. The *Sturdza* Court noted that "[c]onsidering the works *as a whole* is particularly important because protectible expression may arise through the ways in which artists combine *even unprotectible elements*." *Sturdza*, 281 F.3d at 1296.

The Panel's opinion is erroneous as a matter of law and should be examined by this Court because the unambiguous precedent of every Circuit makes clear that the protectible elements of the copyrighted work are to be compared to the allegedly infringing work *as a whole*. *Kohus*, 328 F.3d at 855; *Sturdza*, 281 F.3d at 1296; *Johnson* v. *Jones*, 921 F. Supp. 1573, 1582 (E.D. Mich. 1996), *aff'd in relevant part*, 149 F.3d 494 (6th Cir. 1998). Indeed, there is no case that has ever held that purportedly independently created elements are to be factored out of the allegedly infringing work prior to performing a substantial similarity analysis.

For instance, Hon. Paul V. Gadola, United States District Judge for the Eastern District of Michigan, recently applied the *Kohus* holding as follows:

> Having filtered out the unprotectible elements, the Court now turns to *comparing the remaining, protectible elements of Plaintiff's crashing-witch design to Defendant's crashing-witch figure* to

> determine if, under the ordinary-reasonable-person standard, the two are substantially similar. It is self-evident that there is no similarity between the protectible elements of Plaintiff's design and Defendant's figure.

Winfield Collection Ltd. v. *Gemmy Indus. Corp.*, 311 F. Supp. 2d 611, 671 (E.D. Mich. 2004) (emphasis added, citation omitted).

Thus, although Judge Gadola found no substantial similarity in the works before him, he made clear that he compared the protectible elements of the copyrighted work to the allegedly infringing work as a whole, as required by *Kohus and every other decision except the case at bar. Id. See also Kellman* v *The Coca-Cola Co.*, 280 F. Supp. 2d 670, 676 (E.D. Mich. 2003) (holding that "The first step in the *Kohus* inquiry involves filtering out the unoriginal, and therefore unprotected, elements *of the [copyrighted work]*." (emphasis added))

In an effort to justify its unprecedented decision to "filter out" elements from the allegedly infringing work, the Panel relied upon two cases. However, neither of those cases support the Panel's conclusion, and in fact both cases make clear that the copyrighted work must be compared to the allegedly infringing work *as a whole*.

In *Apple Computer, Inc.* v. *Microsoft Corp.*, 35 F.3d 1435, 1445 (9th Cir. 1994), the Ninth Circuit determined that certain elements had to be filtered out of the copyrighted work because it was undisputed that such elements were being used in the allegedly infringing work *under license* from the owner of the copyrighted work. Thus, these elements could not form the basis of a claim for infringement because they were being used *with the permission* of the copyright holder. Although the Panel correctly recognized that the *Apple* Court permitted the "filtering out" of protectible elements from the *copyrighted work*, because such elements could not form the basis of the alleged infringement due to the license agreement, the *Apple* Court gave

no indication that any elements were to be filtered out of the allegedly *infringing work*. *See also Swirsky* v. *Carey*, 2004 U.S. App. LEXIS 14251, *7 (9th Cir. 2004) (citing its own decision in *Apple*, the Ninth Circuit recently held that "Because the requirement is one of substantial similarity *to protected elements of the copyrighted work*, it is essential to distinguish between the protected and unprotected material in a *plaintiff's work* [*i.e.*, the copyrighted work alleged to be infringed upon]." (emphasis added))

In *Sturdza*, *supra*, the D.C. Circuit *reversed* the grant of summary judgment in favor of the defendant granted by the district court and in fact determined that the issue of substantial similarity must be resolved by a jury. Tellingly, the D.C. Circuit saw "significant similarities in the '*overall look and feel*' of the two designs," and specifically noted that the question it faced was "whether [the allegedly infringing] *end product* (his revised design) is substantially similar to [the copyrighted work], *not how it got that way*." *Id.* at 1297, 1299-1300 (citations omitted, emphasis added). Similarly, the question in the case at bar is whether JATW was substantially similar to the Screenplay, not how it got that way[20]. The jury resolved such question by determining that the protectible elements of the Screenplay were in fact substantially similar to JATW.

In addition, the *Sturdza* Court further recognized that, "because substantial similarity is customarily an extremely close question of fact, summary judgment has traditionally been frowned upon in copyright litigation." *Id.* at 1296 (citing, among other cases, *Wickham*, 739 F.2d at 1097). *See also Kohus*, 328 F.3d at 853.

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20. Fox, however, through its affirmative defense of independent creation, could and did seek to explain how JATW "got that way," but this explanation was rejected by the jury because Fox did not sustain its burden of proof with respect to its affirmative defense of independent creation. *See Wrench LLC* v. *Taco Bell Corp.*, 256 F.3d 446, 459-460 (6th Cir. 2001), *cert. denied*, 534 U.S. 1114 (2002).

Recently, in *Tufenkian Import/Export Ventures, Inc.* v. *Einstein Moomjy, Inc.*, 338 F.3d 127 (2d Cir. 2003), the Second Circuit analyzed a district court's decision granting summary judgment in favor of an alleged infringer of a carpet design. The district court had granted summary judgment inasmuch as it determined that "whatever substantial similarity there may be [between the works] emerges from unprotected public domain materials in the allegedly infringing design." *Id.* at 129.

The Second Circuit reversed the district court's ruling by applying the "discerning observer test." *Id.* at 130. This test is "intended to emphasize that substantial similarity must exist between the defendant's allegedly infringing design and the *protectible* elements in the plaintiff's design." *Id.* (italics in original).

The Second Circuit went on to hold in *Tufenkian* that it has "often found it productive to assess claims of inexact-copy infringement by comparing the contested design's 'total concept and overall feel' with that of the allegedly infringed work." *Id.* at 133. Indeed, the Second Circuit noted that this Court's decision in *Feist Pubs., Inc.* v. *Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991), mandates the protection of "total concept and overall feel" inasmuch as this Court held in *Feist* that "compilations of unprotectible elements merit copyright protection insofar as they contain an original and non-mechanical selection, coordination or arrangement of those elements." *Id.* at 134 n.7.

The Second Circuit explained the importance of analyzing the works as a whole as follows:

> Essentially, *the total-concept-and-feel locution functions as a reminder that, while the infringement analysis must begin by dissecting the copyrighted work into its component parts in order to clarify precisely what is not original, infringement analysis is not simply a matter of ascertaining similarity between components viewed in isolation.* For the

> defendant may infringe on the plaintiff's work not only through literal copying of a portion of it, but also by parroting properties that are apparent only when numerous aesthetic decisions embodied in the plaintiff's work of art — the excerpting, modifying, and arranging of public domain compositions, if any, together with the development and representation of wholly new motifs and the use of texture and color, etc. — are considered in relation to one another. The court, confronted with an allegedly infringing work, must analyze the two works closely to figure out in what respects, if any, they are similar, and then determine whether these similarities are due to protected aesthetic expressions original to the allegedly infringed work, or whether the similarity is to something in the original that is free for the taking. (emphasis added).

In *Mattel, Inc.* v. *Goldberger Doll Mfg. Co.*, 365 F.3d 133 (2d Cir. 2004), the Second Circuit reversed the decision of the district court granting summary judgment in favor of the alleged infringer. Mattel, Inc. ("Mattel"), the copyright holder, owned the copyright on the famous "Barbie doll." *Id.* at 133. The alleged infringer created a doll named the "Rockettes 2000" doll. *Id.* Mattel asserted that the Rockettes 2000 doll infringed upon its copyright in the Barbie doll inasmuch as the central features of the faces of both dolls were, according to Mattel, substantially similar. *Id.*

The Second Circuit rejected this proposition and held:

> *The proposition that standard or common features are not protected is inconsistent with copyright law.* To merit protection from copying, a work need not be particularly novel or unusual. It need only have been "independently created" by the author and possess "some minimal degree of creativity." *Feist Publ'ns, Inc.* v. *Rural Tel. Serv. Co.*, 499 U.S.

> 340, 345, 113 L. Ed. 2d 358, 111 S. Ct. 1282 (1991). As the Supreme Court has explained, the "requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, no matter how crude, humble or obvious it might be." *Id.* (internal quotation marks omitted). There are innumerable ways of making upturned noses, bow lips, and widely spaced eyes. Even if the record had shown that many dolls possess upturned noses, bow lips, and wide-spread eyes, it would not follow that each such doll - assuming it was independently created and not copied from others - would not enjoy protection from copying. We have often affirmed entitlement to copyright protection so long as the work was in fact created by its author, notwithstanding "lack of creativity," *Thomas Wilson & Co.* v. *Irving J. Dorfman Co.*, 433 F.2d 409, 411 (2d Cir. 1970) (lace design, although not a "work of art," possessed "more than the faint trace of originality required"), "lack of artistic merit," *Rushton* v. *Vitale*, 218 F.2d 434, 435-36 (2d Cir. 1955) (chimpanzee doll showed more than "merely trivial" originality), and absence of anything "strikingly unique or novel," *Alfred Bell & Co.* v. *Catalda Fine Arts, Inc.*, 191 F.2d 99, 102-03 (2d Cir. 1951) ("All that is needed ... is that the author contributed something more than a merely trivial variation, something recognizably his own. Originality in this context means little more than a prohibition of actual copying. No matter how poor artistically the author's addition, it is enough if it be his own.") (internal quotation marks omitted).

Mattel, 365 F.3d at 135.

The Second Circuit expressly recognized that the use of common features could support the affirmative defense of independent creation, but did not suggest that such features should be ignored in connection with the substantial similarity analysis. The Second Circuit held:

> A properly supported finding that the features of a plaintiff's work are standard or common could have a different significance in a copyright dispute. For example, if the facial features of two dolls were similar not only to each other, but also to those of numerous other dolls available on the market, the similarity would be relatively unlikely to support the inference that the defendant copied from the plaintiff. The defendant might equally have copied from any of the other similar dolls. Alternatively, an observation that features of a work are ubiquitous within an industry might lead a court to doubt that those features are original to the plaintiff. *See, e.g.*, *Acuff-Rose Music, Inc.* v. *Jostens, Inc.*, 155 F.3d 140, 144 (2d Cir. 1998) ("The district court reasonably concluded that the prior usage of the saying was sufficiently widespread as to make it exceedingly unlikely . . . that [the plaintiff] had, in fact, independently created the phrase.").

Id. at 135 n.2.

Thus, it is clear that, under the approach of all circuits, including the Second Circuit, the Sixth Circuit's decision in *Kohus* and this Court's decision in *Feist*, the works must be viewed as a whole because, to do otherwise, would simply eliminate copyright protection for the selection, arrangement and coordination of elements, which this Court has held is worthy of copyright protection. Because the Sixth Circuit failed to properly apply this Court's precedent, this Court should grant the instant Petition.

B. The Panel's Opinion Purports to Grant Copyright Protection to Non-Copyrightable Ideas in Contravention of Well-Settled Precedent as Confirmed by the Sixth Circuit's own Decision in *Kohus*.

It is undisputed that the Treatment is a mere 5½ pages, while Fox's infringing script (which admittedly formed the basis for JATW) is well over 100 pages. R. 339 Tr. Exhs. 49, C6. Therefore, as a matter of law as well as logic, the 5½ page Treatment could not possibly contain all or even most of the *expression* from JATW, which is based upon a script of over 100 pages. In fact, the Treatment registered with the WGA by Kornfield, the purported author of the Treatment and the script for JATW, is not (and could not have been) registered with the United States Copyright Office inasmuch as it is a mere *outline* of the story containing *mere ideas* which themselves are not entitled to copyright protection. *Id.*; Kornfield at TR Vol. XI 26-27.

Nonetheless, the Panel has effectively accorded the Treatment, and the mere ideas contained therein, protectible status under the Copyright Act because it "filtered out" the broad ideas present in the Treatment from JATW *before* performing the substantial similarity analysis. Thus, the Panel gave copyright protection to the mere ideas in the Treatment because, even if a later author set such ideas into concrete expression *before* the creator of such ideas did so, the later-formed expression gains *de facto* copyright protection by virtue of this odd "relation back" theory. Under the Panel's opinion, a defendant accused of infringement is immune from infringing upon *expression* based upon the alleged infringer's prior *ideas*, even though the most fundamental bedrock of copyright law absolutely precludes affording copyright protection to ideas.

The Panel's decision in the case at bar violates the fundamental tenet of copyright law that ideas can not be protected. *Kohus*, 328 F.3d at 855. Specifically, Murray Hill

proved at trial that the various scripts of Fox's infringing work, all of which were prepared after *June* 1994, reveal a process of adding and dropping material *taken directly from the Screenplay*[21] . Murray Hill's expert, Dr. Ira Konigsberg, testified that, based upon his expert review and analysis of the various drafts of Fox's script, Fox must have had a copy or been told about the Screenplay inasmuch as the scripts themselves revealed that Fox used the Screenplay as a virtual blueprint throughout the creative process of revision of its infringing work[22] . Konigsberg at TR Vol. VII 5, Vol. VIII at 109-111; R. 339 Tr. Exhs. N4, P4, Q4-T4, V4, W4, Y4, Z4, A5-O5. Dr. Konigsberg confirmed that he was able to identify that, throughout the various drafts of Fox's infringing work, Fox engaged in the process of adding and dropping material which was directly derived from the Screenplay. *Id.* Thus, Fox used protected *expression* in the Screenplay as a blueprint for its preparation of JATW. Such wholesale appropriation of protected expression is absolutely forbidden by copyright law, regardless of whether Kornfield had created bare ideas prior to the date that Murray Hill could definitively prove that Fox had received copies of the Screenplay.

Even if Fox's Treatment contained ideas which were transformed into expression in JATW, the timing of Fox's creation of those *ideas* is of *no moment* in connection with the

21. Indeed, it is undisputed that Webster registered the Screenplay in 1989, approximately *5 years* before Kornfield's Treatment, but Murray Hill only had definitive proof that Fox received a copy of the Screenplay in July 1994. It is, however, undisputed that Fox did not begin preparing its more than twenty drafts of JATW until after July 1994, and did not complete the process of rewriting until July 1996 by which time Fox undisputedly had had access to the Screenplay for at least *two years*. R. 339 Trial Exhs. N4, P4-T4, V4, W4, Y4, Z4, A5-O5

22. Dr. Konigsberg was clearly correct in his analysis that Fox must have had a copy of the Screenplay at the time it was creating drafts of JATW because it is undisputed that Fox in fact had copies of the Screenplay through its agents and representatives, Matoian, Rothman, Gartner and Romero.

substantial similarity analysis because the jury was properly instructed not to compare ideas *at all*. Indeed, the only relevant timing is Fox's creation of the *expression* which infringed upon Murray Hill's protected and copyrighted expression, and which was undisputedly created only *after* Fox admittedly had possession of the Screenplay. Thus, this Court should grant the instant Petition in order to ensure that authors are free to use any ideas they see fit in preparing their works, and to further ensure that only the expression of such ideas, not the ideas themselves, receive copyright protection.

C. The Panel's Opinion Conflicts with Well-Settled Precedent Regarding the Affirmative Defense of Independent Creation, Including the Sixth Circuit's Own Decision in *Wrench*.

The very cases cited by the Panel as purported support for its conclusion unequivocally demonstrate that evidence of a work which predates the copyrighted work is to be used *solely as support for the affirmative defense of independent creation*.

For instance, in the seminal copyright decision of *Sheldon* v *Metro-Goldwyn Pictures*, 81 F.2d 49, 54 (2d Cir. 1936), the defendant asserted that it independently created the allegedly infringing work based in part upon works in the public domain, and had not copied the plaintiff's work. The Second Circuit, through Judge Learned Hand, held that, "[i]f the defendant has had access to other material which would have served him as well [as the plaintiff's copyrighted work], his disclaimer [*i.e.*, assertion of independent creation] *becomes more plausible*." *Id.* at 54 (emphasis added). Thus, the *Sheldon* Court, like every other court, recognized that access to other material can support an affirmative defense of independent creation, but can not and does not justify "filtering out" such material from the allegedly infringing work. *See also Grubb* v. *National Football League Properties, Inc.*, 901 F. Supp. 36, 39 (D. Mass. 1995) (holding that the draft of a football team logo created before the defendant had access to the copyrighted logo supports

the defendant's affirmative defense of independent creation), *aff'd*, 88 F.3d 1 (1st Cir. 1996).

Although the Panel considered the issue of "filtering out" purportedly independently created elements from the allegedly infringing work one of first impression, that is simply not the case. The well-settled law of copyright accounts for and embraces this very issue by and through the universally recognized affirmative defense of independent creation. The Sixth Circuit, in accord with the majority of other Circuits, has held that independent creation is an *affirmative defense* to a claim of copyright infringement, and therefore the burden of proof is upon the party asserting such affirmative defense. *Wrench*, 256 F.3d at 459-460. Although this Court has not squarely addressed the issue, it has held that independent creation is a defense to copyright infringement. *See Feist*, 499 U.S. at 353.

That is, a defendant accused of infringement is fully entitled, in support of its affirmative defense of independent creation, to point out each element in its allegedly infringing work which it contends was independently created, and present evidence supporting this position. In this case, Fox did exactly that. Specifically, Fox asserted the affirmative defense of independent creation of JATW and, as support for its position, offered evidence that it had created the Treatment prior to Fox's undisputed access to the Screenplay. *See, e.g.*, Closing Argument of Fox's counsel at TR Vol. XIX 72-76. The jury heard this evidence *and specifically rejected Fox's affirmative defense of independent creation*. R. 247 Verdict.

Although the Panel asserts that "logic supports the filtering of independently-created elements," the exact opposite is true[23].

23. In any event, the Panel's bald statement puts the cart before the horse, and demonstrates that the Panel engaged in making factual determinations which ignore, and indeed contradict, the factual findings of the jury. That is, only the jury can decide which elements were (Cont'd)

Copyright law recognizes that all protectible elements in the copyrighted work must be compared to the allegedly infringing work *as a whole* because, to do otherwise, would permit an alleged infringer to reduce the allegedly infringing work to virtually nothing by asserting that various elements in the allegedly infringing work were derived from sources other than the copyrighted work, and therefore such elements should not be part of the substantial similarity comparison. This effectively serves to shift the burden of proof with respect to the affirmative defense of independent creation from the alleged infringer to the copyright holder by requiring the copyright holder to prove that certain elements (including bare ideas) were not independently created.

In fact, logic dictates, in accord with the great weight of authority, that *nothing* should be filtered out of the allegedly infringing work because it must be viewed as a whole. *See, e.g., Kohus*, 328 F.3d at 855; *Sturdza*, 281 F.3d at 1296; *Johnson*, 921 F. Supp. at 1582. Specifically, to the extent an alleged infringer contends that the allegedly infringing work (or any portion thereof) was independently created, it is free to so assert and present evidence supporting such assertion.

(Cont'd)

independently created based upon the affirmative defense of independent creation. To the extent the jury accepted Fox's proof that it had independently created any element, the jury necessarily would have removed such element from its consideration of copyright infringement because a finding of independent creation, by definition, negates copying. R. 286 Pl.'s Br. in Opp. to Def.'s Mot. for New Trial, Exh. M at 28. The jury clearly rejected Fox's positions that it independently created JATW inasmuch as it determined that Fox was liable for copyright infringement.

D. The Panel's Opinion Removed the Fact Finding Function from the Exclusive Province of the Jury in Contravention of Well-Settled Precedent.

The Panel attempted to justify its opinion, which effectively removed the determination of the factual issues of substantial similarity and independent creation from the jury, by asserting that "no reasonable jury could have found substantial similarity solely on the basis of the six" elements which were not "filtered out" of JATW as a result of the Court's erroneous filtering analysis outlined above.

However, it is well settled that, because "similarity is clearly a question of fact," the only circumstances under which an appellate court may reverse a finding of similarity is if "there is *no evidence* of substantial similarity, or if the only substantial similarity is as to *noncopyrightable matter*." 3 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright*, § 12.12 (emphasis added). In this case, the Panel acknowledged that there is *some* similarity between the works, and further acknowledged that this similarity existed between *protectible elements* of the Screenplay and elements which even the Panel admitted should be considered when reviewing JATW, although the Panel did not believe that these similarities were sufficient to raise a triable issue of fact. Thus, at a minimum, it would have been appropriate for the Panel to remand this case so that a jury could determine whether the remaining similarities were sufficient to raise an inference of copying such that Fox should be held liable for copyright infringement.

In any event, judgment as a matter of law is entirely improper in these circumstances. The Second Circuit held:

> We have recently held that when a copyright plaintiff establishes a *prima facie* case of infringement and the defendant adduces testimony of interested parties claiming independent creation, the plaintiff

> need not present direct evidence contradicting the independent creation theory to avoid summary judgment. Both the evidence of access and similarity, on the one hand, and of independent creation, on the other, are relevant to the ultimate issue of copying, and the conflict of that evidence creates a material issue of fact; on such a record we may not enter summary judgment for either party. *Langman Fabrics* v. *Graff Californiawear, Inc.*, 160 F.3d 106, 115-116 (2d Cir. 1999) (citations omitted).

In a case similar to the case at bar, famed composer Andrew Lloyd Webber ("Webber") was sued for allegedly copying a song for his musical, "The Phantom of the Opera." *Repp* v. *Webber*, 132 F.3d 882 (2d Cir. 1997). Webber asserted, among other things, independent creation on the basis that he derived the allegedly infringing song from his own works which predated the copyrighted work at issue. *Id.* at 886. The Second Circuit recognized that this evidence went to the affirmative defense of independent creation, but did not "filter out" this material from the allegedly infringing work and further recognized that only the finder of fact could resolve this issue. *Id.* at 891. The Second Circuit explained as follows:

> [T]he district court *accepted only the version of interested witnesses on the question of separate creation*. But Professor Mack for the plaintiffs specifically found that the two pieces of music "are so similar as to preclude separate creation." Here, again, the district court erred by undertaking the resolution of a disputed issue of material fact. We have previously determined that independent creation is an affirmative defense and may be used to rebut a *prima facie* case of infringement. The plaintiffs here have established a *prima facie* case of access through striking similarity, which certainly includes the element of probative similarity.

> *Whether the evidence of independent creation here is sufficient to rebut the prima facie case established in this action is a question for the factfinder*, whatever the contours of the burden of establishing the defense. *Id.* (citations omitted, emphasis added).

The Panel's holding utterly eviscerates all these well-settled principles inasmuch as the Panel apparently weighed the evidence and accepted Fox's self-serving position that those portions of JATW which Fox asserts resemble the ideas contained in the Treatment were in fact independently created and should be "filtered out." This was an improper encroachment upon the jury's exclusive fact-finding function. Therefore, this Court should grant the instant Petition in order to reiterate the well-settled principle that only the finder of fact can resolve factual disputes and a court may not do so in connection with motion for judgment as a matter of law.

CONCLUSION AND RELIEF SOUGHT

For all the foregoing reasons, Murray Hill respectfully requests that this Honorable Court grant the instant Petition for Writ of Certiorari.

Respectfully submitted,

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